



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: Box ISSUE FEE  
ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

**NOTICE OF ALLOWANCE AND ISSUE FEE DUE**

18N2/1001

PENNIE & EDMONDS  
1155 AVENUE OF THE AMERICAS  
NEW YORK NY 10036-2711

APPLICATION NO.	FILING DATE	TOTAL CLAIMS	EXAMINER AND GROUP ART UNIT	DATE MAILED
08/738,944	10/24/96	025	BRUSCA, J 1805	10/01/97
First Named Applicant	PETERSON, TODD C.			

TITLE OF METHODS FOR GENERATING AND SCREENING NOVEL METABOLIC PATHWAYS  
INVENTION

ATTY'S DOCKET NO.	CLASS-SUBCLASS	BATCH NO.	APPLN. TYPE	SMALL ENTITY	FEE DUE	DATE DUE
1 8757-007	435-172.300	555	UTILITY	YES	\$650.00	01/02/98

**THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED.**

**THE ISSUE FEE MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED.**

**HOW TO RESPOND TO THIS NOTICE:**

I. Review the SMALL ENTITY status shown above.  
If the SMALL ENTITY is shown as yes, verify your current SMALL ENTITY status:

- A. If the status is changed, pay twice the amount of the FEE DUE shown and notify the Patent and Trademark Office of the change in status, or
- B. If the status is the same, pay the FEE DUE shown above.

If the SMALL ENTITY is shown as NO:

- A. Pay FEE DUE shown above, or
- B. File verified statement of Small Entity Status before, or with, payment of 1/2 the FEE DUE shown above.

II. Part B of this notice should be completed and returned to the Patent and Trademark Office (PTO) with your ISSUE FEE. Even if the ISSUE FEE has already been paid by charge to deposit account, Part B should be completed and returned. If you are charging the ISSUE FEE to your deposit account, section "6b" of Part B should be completed.

III. All communications regarding this application must give application number and batch number.  
Please direct all communication prior to issuance to Box ISSUE FEE unless advised to the contrary.

**IMPORTANT REMINDER: Patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.**

## Notice of Allowability

Application No.  
**08/738,944**

Applicant(s)  
**Peterson et al.**

Examiner  
**John S. Brusca**

Group Art Unit  
**1805**



All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance and Issue Fee Due or other appropriate communication will be mailed in due course.

☒ This communication is responsive to the Amendment filed 8/25/97.

☒ The allowed claim(s) is/are 1-21 and 25-28.

☐ The drawings filed on \_\_\_\_\_ are acceptable.

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE **THREE MONTHS** FROM THE "DATE MAILED" of this Office action. Failure to timely comply will result in ABANDONMENT of this application. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

☐ Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL APPLICATION, PTO-152, which discloses that the oath or declaration is deficient. A SUBSTITUTE OATH OR DECLARATION IS REQUIRED.

☒ Applicant MUST submit NEW FORMAL DRAWINGS

☐ because the originally filed drawings were declared by applicant to be informal.

☒ including changes required by the Notice of Draftsperson's Patent Drawing Review, PTO-948, attached hereto or to Paper No. 4.

☒ including changes required by the proposed drawing correction filed on 8/25/97, which has been approved by the examiner.

☐ including changes required by the attached Examiner's Amendment/Comment.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the reverse side of the drawings. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

☐ Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Any response to this letter should include, in the upper right hand corner, the APPLICATION NUMBER (SERIES CODE/SERIAL NUMBER). If applicant has received a Notice of Allowance and Issue Fee Due, the ISSUE BATCH NUMBER and DATE of the NOTICE OF ALLOWANCE should also be included.

### Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

☒ Interview Summary, PTO-413

☒ Examiner's Amendment/Comment

☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material

☒ Examiner's Statement of Reasons for Allowance

Serial Number: 08/738944

Art Unit: 1805

Page 2

#16/C  
JH  
9/29/97

***Election/Restriction***

1. Applicant's election of Group I in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. This application is in condition for allowance except for the presence of claims 22-24 drawn to an invention non-elected without traverse. Accordingly, claims 22-24 have been canceled without prejudice.

**EXAMINER'S AMENDMENT**

3. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Laura A. Coruzzi on 9/27/97.

4. The application has been amended as follows:

On page 1, the title has been deleted.

On pages i-iii, the page numbers in the Table of Contents have been deleted.

Art Unit: 1805

On page 14, line 3, a new paragraph has been started before "Figure 6C".

On page 36, line 35, the blank accession number has been deleted and --B21637N-- has been substituted therefor.

On page 106, line 3, the blank accession number has been deleted and --B21637N-- has been substituted therefor.

On page 86, line 1, "(SEQ ID No. 3)" has been deleted.

On page 86, line 2 after "GCC AAT" the phrase --(SEQ ID No. 3)-- has been inserted.

In claim 1, line 4, "fragment" has been deleted and --fragments-- has been inserted therefor.

In claim 4, line 1, a comma has been inserted after "2".

In claim 6, line 1, a comma has been inserted after "2".

In claim 7, line 1, a comma has been inserted after "2".

In claim 10, , line 3, "product" has been deleted and --products,-- has been substituted therefor.

In claim 11, line 3, "product" has been deleted and --products,-- has been substituted therefor.

In claim 12, line 3, "product" has been deleted and --products,-- has been substituted therefor.

In claim 16, line 1, a comma has been inserted after "14".

In claim 17, line 1, a comma has been inserted after "14".

Art Unit: 1805

In claim 27, now claim 24, line 1, a comma has been inserted after "2".

Claims 22-24 are canceled.

5. The following is an examiner's statement of reasons for allowance:

The objection to the specification regarding the identification of the sequences that appear in the figures with SEQ ID numbers in the Office Action mailed 5/27/97 is withdrawn in view of the Amendment filed 9/26/97.

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 8/25/97 have been approved. The objection to Figure 5E in the Office Action mailed 5/27/97 is withdrawn in view of the proposed drawing correction.

The rejection of claims 1-21, 25, and 26 under 35 U.S.C. § 112, second paragraph in the Office Action mailed 5/27/97 is withdrawn in view of the Amendment filed 8/25/97.

The terminal disclaimer filed on 8/25/97 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on application number 08/639255 has been reviewed and is accepted. The terminal disclaimer has been recorded. The rejection of claims 1-21, 25, and 26 under the judicially created doctrine of obviousness type double patenting in the Office Action mailed 5/27/97 is withdrawn in view of the terminal disclaimer filed 8/25/97.

The Declaration by Assignee filed 9/24/97 stating that the claimed invention of the instant application and copending application 08/738944 were commonly owned at the time of

Art Unit: 1805

invention obviates any possible rejection under 35 U.S.C. § 103 based on references that qualify under 35 U.S.C. § 102 (f) or (g).

The provisional rejection of claims 1-21, 25, and 26 under 35 U.S.C. § 103(a) as being obvious over copending Application No. 08/639255 which has a common inventor in the instant application in view of Frost et al. in the Office Action mailed 5/27/97 is withdrawn because the effective filing date of the claimed invention in the instant application is identical with the effective filing date of the disclosure of the claimed invention (a library of cDNA or genomic DNA derived from multiple species of organisms) in copending Application No. 08/639255 and in the absence of such a disclosure, the claimed invention in the instant application would not be obvious over Frost et al.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

6. Certain papers related to this application may be submitted to Art Unit 1805 by facsimile transmission. The FAX number is either (703) 308-4242 or (703) 305-3014. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6 (d)).

Art Unit: 1805

NOTE: If applicant *does* submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Brusca, Ph.D. whose telephone number is (703) 308-4231. The examiner can normally be reached on Monday through Friday from 9 AM to 5 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Elliott, Ph.D., can be reached at (703) 308-4003.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

John S. Brusca, Ph.D.



Examiner



JAMES KETTER  
PRIMARY EXAMINER  
GROUP 1800